

Remarks/Arguments

Claims 1-59, and 64-67 are pending in the application. Claims 60-63 are withdrawn from consideration, as deemed drawn to an unelected species.

Rejections lacking in supporting detail

Claim 33 and 53-54 were summarily rejected under section 102(e) in view of Rodkin. However, the Office Action includes no detail and does not attempt to develop a prima facie case of anticipation for these claims. In addition, "Applicant's arguments ... have been considered but are moot in view of the new ground(s) of rejection." These statements indicate that rejecting claim 33 and 53-54 in light of Rodkin was in error and should be withdrawn.

Claim 59 was summarily rejected under section 102(e) in view of Rodkin. However, the Office Action includes no further detail to develop a prima facie case of anticipation beyond this summary allegation. Because of this lack of detail, no case for anticipation by Rodkin is advanced in the Office Action for claim 59. Applicant requests that this rejection be withdrawn.

Applicant notes that claims 55-59 are dependent from claim 54, yet were not rejected under Van der Meer by the Office Action. Accordingly, Applicant believes this establishes that each of claims 55-59 is not anticipated by Van der Meer and that each of claims 55-59 contains a limitation not taught or suggested by Van der Meer.

Descriptive material

As an initial point, the Office Action alleges several limitations present in the claims are "non-functional descriptive material." Regarding claims 2-4, 26, 29-30, 32, and 46 that "specific limitations as to which computer system embeds the code into the document is non-functional descriptive material." The Office Action reasons that "[t]he step preceding the embedding is performed the same regardless of which computer embeds the code." While claims may contain

non-functional descriptive material, the Office Action misidentifies these claim limitations as such. This understanding is inconsistent with the law. Steps in a method may be specified either by what is ultimately accomplished or by underlying acts that disclose how that step is accomplished. Steps claiming underlying function without recitation of acts for performing that function are treated under 112 par. 6 while steps reciting underlying acts are construed as ordinary limitations. MPEP 2181, citing *Seal-Flex, Inc. v. Athletic Track and Court Construction*, 172 F.3d 836, 850, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999) (Radar, J., concurring). Neither of these is "non-functional descriptive material." Specifying a particular server to perform a particular act is an underlying act. The Office Action classifies an underlying act as "non-functional" while suggesting a paragraph 6 limitation be treated as a non-paragraph 6 limitation. This vitiates limitations despite their meaning to a person of ordinary skill. Claims must be construed "in light of the specification as it would be interpreted by one of ordinary skill in the art." MPEP 2111, citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004). The limitation of which computer performs a task is not "non-functional."

Similarly the Office Action alleges regarding claims 6-9, 34-38, 47, and 51 that "limitations of the types of additional information that are received from the user selected annotation are non-functional descriptive material." In addition, the Office Action alleges regarding claims 13-15 that "the type of information being retrieved is non-functional descriptive material." The Office Action reasons that for "purchase information, historical information, news articles, the retrieval process will be the same no matter the type of information being retrieved." This is incorrect. For example, Google has a URL (<http://www.google.com/prdhp?tab=wf>) for product searches different from the search URL for web pages (<http://www.google.com/>). This is one example of different retrieval processes for different types of information. As above, downloading a particular type of information is an underlying act and a positive limitation that must be demonstrated as part of a prima face case for anticipation.

Rejections under Rodkin

The Office Action rejects claims 1-59 as anticipated by Rodkin (US Pat. 6,581,065). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Rodkin, however, fails to teach or suggest at least one element of every rejected claim. While every reason why each claim is not anticipated has not been presented, a prima facie case for anticipation of each claim has not been established for at least the reasons below.

While each claim uses slightly different language, the general arguments to distinguish Rodkin presented are as follows. First, Rodkin's operation happens entirely on the server side. Accordingly, there is no client side code, no annotation instructions for the client, storage and transmission of data do not match claim limitations, and there are no new annotations generated on the client. Second, Rodkin does not contemplate any role for the Internet service provider. Third, Rodkin does not disclose including information about products. Fourth, Rodkin's relational databases are not adapted for use by the client's browser. Fifth, Rodkin's one computer, one transmission architecture does not match the claims.

A. Rodkin's operation is entirely server side.

1. Rodkin has no client side code.

Rodkin's processing happens entirely on the server side, no client processing is contemplated. Rodkin recites that a "content server 410 processes an on-line text article 405 ... to automatically associate hypertext anchor codes with various character strings." Col. 12, lines 39-42. Rodkin teaches that the Web surfer's browser interacts passively without executing code; the "browser 435 communicates with the content server 410," "[t]he Web surfer clicks on ...

hypertext,” and “the Web surfer’s browser 435 then communicates with a third party server 445.”

Col. 13, lines 11-19. Rodkin Fig. 4 shows an Intelligent Annotator Executable 412 and CGI script 420 running on the content server, not in the user’s browser. Accordingly, Rodkin fails to anticipate claims that require client side code.

Claim 1 recites “code executable by a client computer.” Rodkin fails to disclose or suggest “code executable by a client computer.”

Claims 22 recites a “client computer having executable code.” As noted above, Rodkin discloses no code executable by the client. Rodkin fails to disclose or suggest a “client computer having executable code.”

Claim 45 recites, in part, “transmitting to a consumer computer system a consumer code executable on the consumer computer system.” Rodkin fails to disclose or suggest “transmitting to a consumer computer system a consumer code executable on the consumer computer system .”

2. Rodkin generates no “annotation instructions” for the client.

Similarly, there are no “annotation instructions for the client computer.” The Office Action cites column 12, lines 39-42 of Rodkin as disclosing “[g]enerating annotation instructions for the client computer.” This passage recites a “content server 410 processes an on-line text article using an Intelligent Annotator(TM) 412 to automatically associate hypertext anchor codes with various strings in the article.” Rodkin’s “annotator,” however, does not generate annotation instructions for the client. Rodkin discloses inserting HTML links to “corresponding destination addresses, such as URLs.” Col. 11, lines 30-31. This hyperlinked text is downloaded to the client. Thus the extent of Rodkin’s “annotation instructions for the client computer” are HTML link tags. A link is not an “annotation instruction.” “[T]he present invention satisfies the need for systems that annotate Web documents to provide expanded functionality, such as dynamic

analysis and embedding of expanded information in the form of one or more hyperlinks, executable code, and/or other text or objects of annotated words or strings.” Specification page 6, line 22 – page 7, line 3. One example of such annotation instructions is the recitation in claim 18 of “annotation instructions [that] direct the *creation* of a hyperlink.” In contrast, Rodkin merely sends a document that includes a hyperlink – this is not an “annotation instruction.”

Claim 1 recites “generating annotation instructions for the client computer.” Rodkin does not teach or suggest “annotation instructions for the client computer.”

Similarly, claim 20 recites “sending annotation instructions from the first computer system to the second computer system.” Rodkin does not show “sending annotation instructions from the first computer system to the second computer system.” Rodkin does not teach or suggest “sending annotation instructions from the first computer system to the second computer system.”

Claim 48 recites “code ... to generate annotation instructions for the client computer system.” As noted, Rodkin does not teach or suggest annotation instructions for the client, much less code to generate such annotation instructions. Rodkin does not teach or suggest “code ... to generate annotation instructions for the client computer system.”

3. Rodkin lacks proper storage and transmissions.

Because Rodkin's operation happens on the server, claim 20 is not anticipated. Claim 20 recites a “first computer system.” Specifically, claim 20 recites “on a first computer system, receiving over a packet-switched network a web page.” Rodkin recites that “browser 435 communicates with the content server 410 to access the on-line article.” Col. 13, lines 11-13. This suggests that the Rodkin's Web surfer's computer might be a “first computer system” within claim 20, while the Rodkin's content server cannot be such a “first computer system.” However, claim 20 also recites “on the first computer system, recognizing in a web page one or more

predetermined key elements.” Even if Rodkin's Intelligent Annotator(TM) performs such a recognition function, it does not operate on “the first computer system.” Accordingly, Rodkin fails to teach or suggest a “first computer system.”

Because Rodkin's substitution operates entirely on the server-side, data resources used in the that substitution are not downloaded to the client. Claim 22 recites “sending a key list from a remote computer system to a client computer system ... the key list comprising a set of key elements and corresponding identifiers.” The Office Action references col. 12, lines 45-49 as showing “[r]ecognizing key elements in the document based on the key elements in the key element list.” Rodkin recites “a master database of specific words or phrases ... as well as a database of corresponding destination addresses.” Col. 11, lines 29-31. Rodkin also recites “a master annotation database which stores character strings which are associated with preferred destination addresses.” Col. 11, lines 62-64. Even assuming, arguendo, that one or these databases is a “key list,” there is no indication in Rodkin that either database is ever sent to the client computer system. Accordingly, Rodkin does not teach or suggest “sending a key list from a remote computer system to a client computer system.”

Similarly, data required on the client by claim 45 is never downloaded. Claim 45 recites, in part, “a consumer code executable on the consumer computer system for (i) recognizing predetermined key elements on an electronic document.” The Office Action references col. 11, lines 29-31 and lines 62-64 as showing “[r]ecognizing key elements in the document based on the key elements in the key element list.” Lines 29-31 recite “a master database of specific words or phrases ... as well as a database of corresponding destination addresses.” Even assuming, arguendo, that this these components involve predetermined key elements recited by claim 45, there is no indication in Rodkin that these structures are ever sent to the consumer computer system. Rodkin recites “a master database of specific words or phrases ... as well as a database of corresponding destination addresses.” Col. 11, lines 29-31. Rodkin also recites “a

master annotation database which stores character strings which are associated with preferred destination addresses.” Col. 11, lines 62-64. Again, even assuming for the sake of argument that that these are predetermined key elements recited by claim 45, there is no indication they are ever sent to the “consumer computer system.”

Because there is no client-side execution, “a first computer system,” as recited by claim 49, does not exist. Specifically, claim 49 recites “computer code stored in memory on a first computer system.” Rodkin's web surfer's browser 435 cannot be a “first computer system.” Rodkin teaches that the Web surfer's browser interacts passively without executing code; the “browser 435 communicates with the content server 410,” “[t]he Web surfer clicks on ... hypertext,” and “the Web surfer's browser 435 then communicates with a third party server 445.” Col. 13, lines 11-19. Rodkin Fig. 4 shows and the Intelligent Annotator Executable 412 and CGI script 420 running on the content server, not in the user's browser. Accordingly, the web surfer's browser 435 cannot be a “first computer system” because it lacks “computer code stored in memory.” However, claim 49 also recites an “original document, as renderably received by the first computer system.” However, Figure 4 shows that Rodkin's on-line article is not received by the content server 410 nor the central server 450. Accordingly, none of the computer systems Rodkin discloses are a “first computer system” under claim 49. Therefore, Rodkin fails to anticipate claim 49.

4. There are no new annotations on the client.

As noted above, there are no new annotation instructions executed on a client system under the teachings of Rodkin. Even assuming there are annotations merely for the sake of argument, Rodkin does not teach or suggest that new annotations are “being made in addition to those native to the original document.” Rodkin teaches that the Web surfer's browser interacts passively without executing code; the “browser 435 communicates with the content

server 410," "[t]he Web surfer clicks on ... hypertext," and "the Web surfer's browser 435 then communicates with a third party server 445." Col. 13, lines 11-19. Rodkin Fig. 4 shows the Intelligent Annotator Executable 412 and CGI script 420 running on the content server, not in the user's browser.

Claim 48 recites that "annotations are being made in addition to those native to the original document, as renderably received by the first computer system." Because no code executes on the client, Rodkin cannot make new annotations. Rodkin fails to teach or suggest "annotations are being made in addition to those native to the original document, as renderably received by the first computer system."

Similarly, claim 49 recites that "annotations are being made in addition to those native to the original document, as renderably received by the first computer system." As noted above, Rodkin cannot make new annotations on the client. Rodkin fails to teach or suggest "annotations are being made in addition to those native to the original document, as renderably received by the first computer system."

B. Rodkin does not contemplate a role for the Internet service provider.

Rodkin never contemplates the involvement or even the existence of such an Internet service provider. Rodkin fails to appreciate the role of the Internet service provider and even teaches away from awareness of the Internet service provider's role by emphasizing network neutrality and agnosticism. Rodkin discloses use "with virtually any computer network, including intranets, local area networks, and wide area networks." Col 24, lines 52-53.

Claim 4 recites "a computer system associated with the Internet service provider." Because Rodkin fails to recognize the Internet service provider, Rodkin fails to teach or suggest "a computer system associated with the Internet service provider ."

Similarly, claim 58 recites a “server ... controlled by the party controlling the Internet service provider that serves as a conduit for delivery of the web document to the client system.” As noted, Rodkin fails to appreciate the role of the Internet service provider and even teaches away from awareness of the Internet service provider's role.

Accordingly, Rodkin fails to teach or suggest a “server ... controlled by the party controlling the Internet service provider that serves as a conduit for delivery of the web document to the client system.”

C. Rodkin does not teach finding information about products.

Rodkin recites that “search engine 470 searches a computer network such as the Internet using a particular character string as a search term.” Col. 12, lines 26-27. Even assuming for the sake of argument that Rodkin's search engine performs a “search” within claim 7, Rodkin fails to teach or suggest that this is “adapted to find information about products relating to the key element.”

Claim 7 recites a search “adapted to find information about products relating to the key element.” In addition, claim 35 recites, in part, that “the information relates to products.” Additionally, claim 36 recites, in part, “sending product-related information.” Applicant cannot find any reference to information related to products in Rodkin's specification.

Similarly, claim 37 recites, in part, that “product-related information includes products listed by category” and claim 38 recites, in part, that “product-related information includes comparative product information.” Rodkin fails to teach or suggest any product information, much less comparative product information or products listed by category.

D. Rodkin's use of relational databases is not "adapted for" the client computer.

Rodkin notes that the "anchor code and/or destination addresses may be associated with particular character strings using relational database programming techniques." Col. 4, lines 13-15. Rodkin recites "a master database of specific words or phrases ... as well as a database of corresponding destination addresses." Col. 11, lines 29-31. Rodkin also recites "a master annotation database which stores character strings which are associated with preferred destination addresses." Col. 11, lines 62-64.

Claim 22 recites a "key list *adapted for* the client computer." (emphasis added). Rodkin does *not* disclose that the Web surfer's browser or computer has such relational database capabilities, nor are such capabilities common. Consequently, Rodkin teaches away from a key list adapted for the client by teaching storage in way the client computer is likely *incapable of reading*. Rodkin does not teach or suggest a "key list adapted for the client computer."

E. Rodkin's single transmission, single computer architecture fails to match claims.

Because Rodkin teaches only a single transmission of an on-line article (see e.g. Fig. 4), there are not separate transmissions of "an electronic document" and "instructions" as required by claim 27. Claim 27 recites "on a first computer system, receiving an electronic document." Claim 27 also recites "from a second computer ... sending instruction to the first computer." Because these are separate steps, the sending and receipt occur in separate transmissions. However, Rodkin discloses only that a "Web surfer's browser 435 communicates with the content server 410 to access the on-line article with hypertext 415." Col. 13, lines 11-14. Even assuming for the sake of argument that this on-line article contains "instructions" these "instructions" and the "document" are included in a single transmission. Accordingly, Rodkin does not anticipate claim 27.

In addition, even if Rodkin did show such "instructions," these "instructions" cannot be sent from Rodkin's content server. Claim 27 recites "on a first computer system, receiving an electronic document." Rodkin recites that "browser 435 communicates with the content server 410 to access the on-line article." Col. 13, lines 11-13. This shows that Rodkin's content server cannot be such a "first computer system." Claim 27 also requires that "the second computer system did not provide the electronic document." This means Rodkin's content server cannot be a "second computer system" either. Claim 27 further recites "from the second computer ... sending instructions to the first computer for presenting to the user of the first computer system one or more hyperlinks." Rodkin discloses sending an on-line article from the content server to the Web surfer's browser. Even assuming for the sake of argument that such an on-line article contains "instructions" within the language of claim 27, such a document cannot be sent from the content server because the content server is not the "second computer system."

Rejections under Van der Meer

Claims 33, 53-54, and 64-67 are rejected as anticipated by Van der Meer (US Pat. 6,289,362). As noted above, a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Van der Meer, however, fails to teach or suggest at least one element of every rejected claim. While every reason why each claim is not anticipated has not been presented, a prima facie case for anticipation of each claim has not been established for at least the reasons below.

While each claim uses slightly different language, the general arguments to distinguish Van der Meer are presented below. First, Van der Meer's transfer script is not "annotation." Second, even if Van der Meer does perform "annotation" no annotations are created on the

client. Third, even if Van der Meer does have annotations, the annotations cannot be selected. Fourth, even if Van der Meer has annotations that can be selected, their selection causes transfer not receipt of information. Fifth, Van der Meer does not disclose storage on the client.

A. Van der Meer's transfer script instrumentation is not annotation.

The Office Action does not identify what are considered annotation instructions. However, the AUAs are strongly implied. Van der Meer recites "generating, transferring, and using annotated universal addresses." Col. 1, line 67 - col. 2, line 1. Specifically, Van der Meer recites "diary software 120 [that] receives the [annotated universal addresses] 134 being transferred from the content provider 115, and stores them in an AUA databases ... 156 in user diary data 146." Col. 4, lines 40-44. The Office Action cites col. 12, lines 12-17 as "generating annotation instructions and sending instruction to the client." Col 12, lines 12-17 recite "click[ing] on an 'add' button 520" which "activates function 'F.'" Function F invokes the transfer of an AUA to the diary server. Although annotations instructions are not particularly identified in the Office Action, the prior passage suggests that the AUAs are considered to be annotation instructions and the add button is considered to be an annotation.

Although Van der Meer uses the word "annotated" in labeling AUAs, the AUAs are not annotation instructions. "[T]he present invention satisfies the need for systems that annotate Web documents to provide expanded functionality, such as dynamic analysis and embedding of expanded information in the form of one or more hyperlinks, executable code, and/or other text or objects of annotated words or strings." Specification page 6, line 22 – page 7, line 3. In contrast, Van der Meer adds no expanded information of any kind to an original Web document. The mere instrumentation to transfer content from a client computer to a diary server is not "annotation." The AUAs, therefore, are not annotation instructions, do not assist in creating annotations, and are not elements and identifiers for use in creating annotations.

Claim 33 recites elements and identifiers “for use in creating annotations for key elements on an electronic document.” As noted, the AUAs are not elements and identifiers for use in creating annotations. Therefore, Van der Meer fails to teach or suggest elements and identifiers “for use in creating annotations for key elements on an electronic document.”

B. No annotations are created on the client.

As noted above, Van der Meer’s AUAs are *not* annotations. However, even if Van der Meer’s AUAs are “annotations,” they are not in addition to those native to the document. Van der Meer’s Fig. 1 shows content data 130 as a large box that *includes* AUAs 134. Van der Meer discloses that “content data 130 [is] for browsers to use.” Col. 4, line 10.

Because Van der Meer’s content data provided to the browser already includes AUAs, these AUAs are not “annotations... being made *in addition to those native to the original document*,” as recited by claim 33. (Emphasis added.)

C. There are no annotations which can be selected.

As noted above, Van der Meer’s AUAs are *not* annotations. However, even if Van der Meer’s AUAs are “annotations,” they cannot be selected. While Van der Meer recites “a transfer script 136 that, when executed by the browser 142, enables the transfer of the AUA 134.” Col. 4, lines 22-23. Yet neither execution of the transfer script nor the transfer of the AUA is a “selection.”

Further, claim 33 recites “receiving ... data ... following selection following selection of an annotation by a user.” As noted, AUAs cannot be selected. Therefore, Van der Meer does not teach or suggest “receiving ... data ... following selection following selection of an annotation by a user.”

D. Van der Meer's *transfer* script does not *retrieve* information.

As argued above, Van der Meer's AUAs are not "annotations" and cannot be "selected." Even if the AUAs are annotations and activation of the transfer script is a selection, the transfer script does not retrieve information. Van der Meer recites "a transfer script 136 that, when executed by the browser 142, enables the transfer of the AUA 134." Col. 4, lines 22-23. Because "transfer" is the opposite of "retrieve," the *transfer* script does not *retrieve* information.

Claim 53 recites, in part, "that a user presented the electronic page can retrieve information related to the key element by selecting the annotation." As noted, the transfer script does not retrieve information.

E. Even if Van der Meer recognizes and annotates, it is only on the content provider.

Van der Meer does not "annotate." Even if Van der Meer does annotate, this happens on the content provider. Van der Meer Figure 4 shows a browser 435 requesting an on-line article from the content server. Figure 5 shows that the content server converts the article to be annotated 405 into the annotated article 415. This is not "annotation" within the language of the claims. However, even assuming for the sake of argument that the content server is performing annotation, the content server is also "providing the document." The only "annotation" happens on Van der Meer's content server.

Claim 53 recites that an "annotation module recognizes and annotates key elements in the document that were not previously recognized and/or annotated by the content provider providing the document." Similarly, claim 54 recites, in part, that "the client computer system recognizes and annotates key elements in the document that were not previously recognized and/or annotated by the content provider providing the document." In addition, claim 64 recites, in part, a "central computer system [that] recognizes key elements ... not previously recognized and/or annotated by the content provider." Claim 66 recites a "key list ... to recognize key

elements in the electronic document that were not previously recognized and/or annotated by the content provider providing the document to the consumer computer.” Finally, claim 67 recites “computer code [that] operates to recognize and annotate key elements ... not previously recognized and/or annotated by the content provider.” Even if Van der Meer's does perform “annotation,” this happens on the content provider and fails to meet the limitations of these claims.

Similarly, claim 67 recites “annotations ... being made in addition to those native to the original document.” As noted above, Van der Meer's AUAs are *not* annotations. However, even if Van der Meer's AUAs are “annotations,” they are native to the original document. Van der Meer's Fig. 1 shows that content data 130 as a large box that *includes* AUAs 134. Van der Meer discloses that “content data 130 [is] for browsers to use.” Col. 4, line 10. Because Van der Meer's content data provided to the browser already includes AUAs, these AUAs are not “annotations... being made in addition to those native to the original document.” Accordingly, Van der Meer lacks this element of claim 67.

F. Even if Van der Meer discloses annotation instructions, Van der Meer does not disclose sending annotations in a separate transmission from the document.

Claim 65 recites, in part, “on the consumer computer system, receiving an electronic document.” Claim 65 recites a separate step in the method involving “sending instructions to the consumer computer system.” Because the “receiving” and “sending” happen in two separate method steps, two separate communications to the consumer computer system are required. As Figure 4 shows, Van der Meer teaches only a single transmission from the content server to the web surfer's browser. Van der Meer, therefore, cannot disclose both “on the consumer computer system, receiving an electronic document” and “sending instructions to the consumer computer system”; at least one of these elements is absent. Accordingly, claim 65 is not anticipated by Van der Meer.

CONCLUSION

Applicant submits that in view of the foregoing remarks and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested.

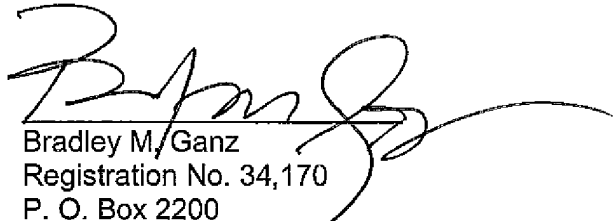
The Commissioner is hereby authorized to charge any fees, including extension fees, or to charge any additional fees or underpayments, including extra claim fees, or to credit any overpayments, to the Credit Card account referenced on the accompanying Credit Card Payment form (PTO-2038). As an alternative, in case the Credit Card cannot be processed, the Commissioner is hereby authorized to charge any fees, additional fees, or underpayments, or to credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

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